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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,136	09/21/2005	Jorg Konze	CS8492/BCC023004	4569
34469	7590	01/24/2006	EXAMINER	
BAYER CROPSCIENCE LP Patent Department 100 BAYER ROAD PITTSBURGH, PA 15205-9741			PAK, JOHN D	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/531,136

Applicant(s)

KONZE ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/11/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

Claims 5-7 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5-7, drawn to a composition wherein component (b) has a benzoylurea structure, i.e. triflumuron and flufenoxuron, classified in class 514, subclasses 588+.
- II. Claims 5-7, drawn to a composition wherein component (b) has a diacylhydrazine structure, i.e. methoxyfenozide and tebufenozide, classified in class 514, subclass 615.
- III. Claims 5-7, drawn to a composition wherein component (b) is thiacloprid, thiamethoxam, dinotefuran or clothianidin, classified in class 514, subclass 229.2, 342, 365 and 471.
- IV. Claims 5-7, drawn to a composition wherein component (b) is deltamethrin, classified in class 514, subclass 521.
- V. Claims 5-7, drawn to a composition wherein component (b) has a phenylpyrazole structure, i.e. ethiprole and fipronil, classified in class 514, subclass 407.
- VI. Claims 5-7, drawn to a composition wherein component (b) is indoxacarb, classified in class 514, subclass 229.2.

Art Unit: 1616

- VII. Claims 5-7, drawn to a composition wherein component (b) is a macrolide, emamectin-benzoate, abamectin and spinosad, classified in class 514, subclasses 28, 30+.

The seven inventions are distinct because each invention utilizes structurally distinct and divergent compounds, as set forth above. None of the compounds can be searched together due to their structural divergence. The search burden for just one of the inventions is already significant due to the extensive prior art collection related to this field of endeavor. The search for the particular mixtures of compounds is a challenging and laborious undertaking because of the broad disclosures found in most patent specifications in this field. As a result, the search and examination of more than one invention group would place an undue burden on the Examiner if the restriction were not required.

For these reasons of distinctness and undue burden, the restriction requirement as set forth above is deemed to be proper.

During a telephone conversation with Mr. Henderson on 1/19/2006 a provisional election was made without traverse to prosecute the invention of Group III, claims 5-7 (to the extent that they read on thiacloprid, thiamethoxam, dinotefuran and clothianidin). Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Art Unit: 1616

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 5-7 will presently be examined to the extent that they read on the elected subject matter.

At the outset of examination on the merits, applicant is advised to clarify claim 6 so that "animal pests" are understood to mean pests of animals such as insects.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (US 2004/0077500) in view of the acknowledged prior art, CABA abstracts 2002:76761, 2002:41456 and 1999:29730.

Sakata et al. teach the insecticidal and acaricidal activity of applicant's component (a). See Sakata's compound 130 in Table 1, column 7, in view of paragraphs 1, 115 (compound 130 listed separately), 123 (compound 130 listed separately), 125 (compound 130 listed separately), page 20 (compound 130 mixed with a structurally similar chloronicotinyl, imidacloprid). Combinations with other insecticidal

Art Unit: 1616

or acaricidal agents are taught (paragraph 28). Specifically mentioned are all four of applicant's elected component (b) compounds. See paragraph 31, lines 24-25.

Appropriate liquid, solid or powdery forms such as emulsion, powder, flowable composition are disclosed for final formulation use (paragraph 33).

Applicant acknowledges that the elected compounds are known insecticides and acaricides (specification page 1, lines 15-18; page 3, lines 1-20).

CABA abstracts 2002:76761, 2002:41456 and 1999:29730 are cited to further establish that the elected component (b) are known pesticides. CABA abstract 2002:76761 discloses that thiacloprid is a highly active chloronicotinyl insecticide with broad spectrum activity against sucking and biting insects. CABA abstract 2002:41456 discloses that thiamethoxam is the first commercial neonicotinoid insecticide from the thianicotinyl subclass, which exhibits "exceptional systemic characteristics and provides excellent control of a broad range of commercially important pests" CABA abstract 1999:29730 discloses that MTI-446 (also known as dinotefuran) controls a broad range of important pests and has a favorable toxicological and environmental profile with low mammalian, avian and aquatic toxicity.

Even though Sakata et al. does not explicitly exemplify compound (a) + any one of thiacloprid, thiamethoxam, dinotefuran and clothianidin, such mixtures would nonetheless have been obvious to the ordinary skilled artisan in this field. Not only does Sakata et al. teach the mixture of their genus of compounds (which includes

Art Unit: 1616

compound (a)) with thiacloprid, thiamethoxam, dinotefuran or clothianidin, Sakata et al. provide a specific disclosure of compound (a) + a similar chloronicotinyl insecticide, imidacloprid. Therefore, the suggestion to also combine compound (a) with other nicotinyl type insecticides is found. Moreover, the secondary references establish that the component (b) compounds are well known insecticides and pesticides, which would have been expected to deliver important pest control activities when combined with compound (a).

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

Applicant's data has been reviewed, but it is unclear whether such data is probative for the entire scope of the claims. The claims presently have no limitation on the amounts, proportions and pests against which the composition is effective. Data in Tables A and B apply only with respect to the use of compound I at non-insecticidal rates. Tables A and B are directed to two specific pests only. The use of non-insecticidal amounts are found in other data and such amounts are not commensurate in scope with that of the claimed subject matter, which reads on all amounts.

With respect to data shown in Table C (with elected component (b) compounds) wherein compound I is used at insecticidal amounts, the Examiner cannot agree at this

time that the Colby method fairly assesses unexpected results. An alternative additive method of individual activity added together reveals non-synergistic results. Review of remaining data shows that similar comments apply thereto. Table D, thiacloprid + I (first mixture) is acknowledged as showing unobvious efficacy, but it is noted that the claims presently do not correspond to the narrow showing therein.

Showing of unexpected or unobvious properties must be commensurate in scope with that of the claimed subject matter. To date, applicant has not shown (i) that the data in the specification is indeed unobvious, and (ii) even if unobvious, the specification data is reasonably commensurate in scope (amounts, proportions, controlled pests) with that of the claimed subject matter.

For these reasons, the claims must be rejected at this time.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Art Unit: 1616

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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